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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,849

10/12/2005

Horst Berneth

CH8351/LeA 36,481

8955

7590

07/29/2008

Lanxess Corporation  
Law & Intellectual Property Department  
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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

07/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,849	<b>Applicant(s)</b> BERNETH ET AL.	
	<b>Examiner</b> Martin J. Angebrannt	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. The full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

The applicant needs to submit a new oath/declaration with the correctly naming - - Wilfried HAESE - - , rather than “Winfried HAESE “ and signed by all applicants.

2. following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 4,9,11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This process does not recite any steps and so does not properly constitute a process. It is a “use claims” which is not permitted under US practice.

Claim 4 is dependent upon both claims 1 and 2, not in the alternative.

Claim 11 is dependent upon claims 10 and 2, not in the alternative. (ie multiply dependent claims)

Claim 14 is dependent upon claims 2 and 12, not in the alternative.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 9-13 is rejected under 35 U.S.C. 102(b) as being fully anticipated by Metz et al. "Synthesis, characterization and conductivity of ( $\mu$ -cyano)(phthalocyaninato)cobalt(III)", J. Am Chem. Soc., Vol. 105(4) pp. 828-830 (1983).

Metz et al. "Synthesis, characterization and conductivity of ( $\mu$ -cyano)(phthalocyaninato)cobalt(III)", J. Am Chem. Soc., Vol. 105(4) pp. 828-830 (1983) teaches dyes of the formula illustrated on page 830. The process for forming this is the oxidation of PcCo with thionyl chloride, to obtain  $\text{PcCoCl}_2$ , which is reacted to sodium or potassium cyanide to form  $(\text{Na,K})\text{PcCo}(\text{CN})_2 \cdot \text{H}_2\text{O}$  and polymerized to form the compounds of formula 2, and then this is treated with a base to form the  $\text{PcCo}(\text{CN})\text{L}$  of formula 3 on page 830.

7. Claims 9-13 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Hanack & Fey, "Synthesis, and properties of peripherally substituted phthalocyaninatocobalt complexes", Recueil des Travaux Chimiques des Pays-Bas Vol. 105(10) pp. 427-433 (10/1986).

Hanack & Fey, "Synthesis, and properties of peripherally substituted phthalocyaninatocobalt complexes", Recueil des Travaux Chimiques des Pays-Bas Vol. 105(10) pp. 427-433 (10/1986) which are oxidized using thionyl chloride, in nitrobenzene, (pages 428), this reaction product was treated with NaCN in boiling ethanol for 3 days (pages 429) and subsequently polymerized by the elimination of NaCN by treatment with hot water and acetone (page 430-431) and these were then treated with ligands to obtain the methyl substituted compounds illustrated on page 432 and the corresponding nitro substituted compound (431-432). See also last two compounds described in page 433.

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8. Claims 1-5,7-11 and 13-15 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Stawitz et al. WO 02/2505 (US 2002/0127366 is English equivalent in used in lieu of a translation).

Stawitz et al. WO 02/2505 teaches the compound of formula 1a where the substituents are the same as in formula I (4/15-11/17)/[0026-0049]. Compounds bounded by formula I which are also desirable are those disclosed with respect to formulae Ib and Ic (11/26-13/8)/[0052-0065]. Examples 22-25 coats the dyes form 2,2,3,3-tetrafluoropropanol, overcoat this with a reflective Ag layer and a UV curable protective layer and record using CD-R techniques. (28/7-30/12)/ [0118-0121]. Useful solvents and mixtures include methanol, ethanol, propanol, TFP, butanol, diacetone alcohol or the like is disclosed (16/8-17/5) / [0086-0088]. The use of the composition with another phthalocyanine dyes is disclosed. (13/10-14)/[0066]. Useful ligands are disclosed (2/9-14 & 6/23-8/17)/[0031,0037-0039].

Clearly, the formula Ia anticipates the compound. The examiner holds that one of ordinary skill in the art would immediately envision optical recording media made using this compound based upon a reading of the specification.

9. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stawitz et al. WO 02/2505 (US 2002/0127366 is English equivalent in used in lieu of a translation).

If it is not upheld that one skilled in the art would immediately envision the media bounded by the claims using compound Ic, the examiner alternatively holds that it would have been obvious to one of ordinary skill in the art to modify the examples by using the dyes bounded by formula Ia with a reasonable expectation of forming a useful optical recording medium as they are taught for this use. Further, it would have been obvious to modify those

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media and coatings compositions by using mixtures of the phthalocyanine dyes disclosed and or mixtures of coating solvents based upon the direction at 16/8-17/5 and 13/10-14.

10. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stawitz et al. WO 02/2505 (US 2002/0127366 is English equivalent in used in lieu of a translation), in view of Asami et al. JP 59-067093.

Asami et al. JP 59-067093 teaches optical recording media having a manganese central metal. The compounds can have two ligands bound to them as in compounds 1-10 or a ligand and a substituent as with compounds 11-15 (table on page 4). Ligands can be compounds having a Pka of 4-10 and include in the table pyridine, methylpyridine, phenylpyridine, hydroxypyridine, aminoisoquinolinepyridine, and ethanol (see notes on reference). There is a more extensive list of possible compounds on page 3.

In addition to the basis above, the examiner holds that it would have been obvious to modify the compounds and media rendered obvious by Stawitz et al. WO 02/2505 by using other ligands, such as the alcohols and other compounds having Pkas of 4-10 taught by Asami et al. JP 59-067093, noting the overlap of the ligands taught by Asami et al. JP 59-067093 and Stawitz et al. WO 02/2505 including pyridine with a reasonable expectation of forming

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebrannt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Martin J Angebranndt/  
Primary Examiner, Art Unit 1795

Martin J Angebranndt  
Primary Examiner  
Art Unit 1795

7/25/2008